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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,722	11/24/2003	Phillip A. Sollami	M121	5385
7590	12/09/2004		EXAMINER	
Robert L. Marsh P.O. Box 4468 Wheaton, IL 60189-4468			KRECK, JOHN J	
			ART UNIT	PAPER NUMBER
			3673	

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/720,722	SOLLAMI, PHILLIP A. <i>PL</i>	
	<b>Examiner</b>	<b>Art Unit</b>	
	John Kreck	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6,8,10-18,21-23,25-28,30 and 31 is/are rejected.
- 7) Claim(s) 7,9,19,20,24 and 29 is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Drawings*

1. Figures 1-5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Objections*

2. Claims 13, 17-20, 23, 24, and 28-30 are objected to because of the following informalities: the preamble of each of these claims refers to "An insert..." but the base claims each call for a tool. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Note that claim 1 is drawn to "An insert for a cutting tool useable..." (preamble) and further includes the limitation "wherein said outer diameter...will engage said ridges" (last two lines). It is apparent that whether or not any portion of the insert will engage a ridge is dependent upon the geometry of the tool which holds the insert (e.g., how deep the socket is), and the geometry of the drum or support which holds the tool (e.g. angle of attack, arrangement of rows of tools). The limitation of "wherein said outer diameter..." cannot be given significant weight in a claim drawn to an insert.

3. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by SU 899916.

4. Claims 1, 3-5, 8, 10, 12-16, 18, 21, 22, 30, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Massa, et al. (U.S. Patent number 5,324,098) Massa shows the insert comprising a forward tip (e.g. 50,56); mid section (60,62) having a first diameter and second diameter; base (e.g. 94,102); fillet (col. 14, line 7) having a maximum diameter; the base defining a cylinder having an outer diameter; and a surface (e.g 84) as called for in claim 1.

Massa teaches the cylindrical portion as called for in claim 3.

Massa teaches the arcuate flanges and indentations as called for in claim 4.

Massa teaches the arcuate flanges approximately 50% of the circumference as called for in claim 5.

Massa teaches the surface nearly planar and sloping rearwardly as called for in claim 8.

Regarding independent claim 10:

Massa shows the tool including a tool body havin a cutting end with a seat and an insert comprising a forward tip (e.g. 50,56); mid section (60,62); base (e.g. 94,102); fillet (col. 14, line 7) having a maximum diameter; the base defining a cylinder having an outer diameter; and a surface (e.g 84) as called for in claim 10.

With regards to claim 12; it is apparent that the base is large enough to engage a ridge (see note above).

Massa teaches the cylindrical portion as called for in claim 13.

Massa teaches the arcuate flanges and indentations as called for in claim 14.

Massa teaches the indentations as called for in claim 15.

Massa teaches the arcuate flanges approximately 50% of the circumference as called for in claim 16.

Massa teaches the surface nearly planar and sloping rearwardly as called for in claim 18.

Regarding independent claim 21:

Massa shows the tool including a tool body having a cutting end with a seat and an insert comprising a tapered cutting tip (e.g. 50,56); mid section (60,62); base (e.g.

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94,102); fillet (col. 14, line 7) having a maximum diameter; the base defining a cylinder having an outer diameter; and a surface (e.g 84) as called for in claim 21.

Massa teaches the arcuate flanges and indentations as called for in claim 22.

Massa teaches the surface nearly planar and sloping rearwardly as called for in claim 30.

Regarding independent claim 31:

Massa shows the tool including a tool body having a cutting end with a seat and an insert comprising a tapered cutting tip (e.g. 50,56); mid section (60,62); base (e.g. 94,102) having a maximum diameter; the base defining a an outer diameter; and a surface (e.g 84) as called for in claim 31. It is apparent that the diameter is sufficient to engage a ridge (see note above).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 11, 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Massa, et al.

Massa fails to teach the diameter greater then 0.750 inch or 1.25 inch. It would have been obvious to one of ordinary skill in the art at the time of the invention to have

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modified the insert of Massa to have a diameter of greater than 0.75 or 1.25 inch as called for in claims 2, 11, and 25. See *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.)

Massa teaches the indentations as called for in claim 26.

Massa teaches the arcuate flanges approximately 50% of the circumference as called for in claim 27.

Massa teaches the cylindrical portion as called for in claim 28.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-6, 8, 10-18, 21-23, 25-28, 30, and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

claims 1-4 of U.S. Patent No. 6,554,369. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are entirely obvious and well known in the prior art.

***Allowable Subject Matter***

9. Claims 7, 9, 19, 20, 24, and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kreck whose telephone number is (703)308-2725. The examiner can normally be reached on M-F 5:30 am - 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703)308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John Kreck  
Examiner  
Art Unit 3673

JOHN KRECK  
PRIMARY EXAMINER

JJK